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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,241	03/13/2001	Deane Gardner	004470.P009	6573

8791 7590 08/25/2004

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EXAMINER

ESCALANTE, OVIDIO

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 08/25/2004

13

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/757,241

Applicant(s)

GARDNER ET AL.

Examiner

Ovidio Escalante

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

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### DETAILED ACTION

1. This action is in response to applicant's amendment filed on May 17, 2004. **Claims 1-47** are now pending in the present application.

#### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. Claims 1-7,11-18,22,23,25-27,29,30,32-34,36,37,39-41,43,44,46 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schweickart et al. US Patent 6,252,883 in view of Uchida et al. WO 00/68913 (priority document of US Patent 6,252,883).

Reference will be made to corresponding US Patent 6,696,956 for purpose of citing the English teachings of the prior art in addition to the Japanese citation. The Examiner has reviewed the Japanese Publication, which has a prior publication date, and believes that there is a direct correspondence between the Japanese Publication and the US National Stage Patent No. 6,252,883. If Applicant has any concerns please feel free to contact the Examiner.

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*Regarding claims 1,12,46 and 47*, Schweickart teaches a method and computer readable medium that provides instruction when executed on a processor for integrating personal data capturing functionality into a wireless/portable communication/computing device, (col. 4, lines 42-51), the method comprising:

receiving personal data of a user by at least one personal parameter receiver, (col. 4, lines 42-51; col. 5, lines 13-16);

capturing the personal data in the wireless/portable communication/computing device, (col. 3, lines 9-24; col. 5, lines 48-53); and

transmitting the personal data from the wireless/portable communication/computing device to a network server over a wireless network, (fig. 1; col. 5, lines 17-25, 48-56).

Schweickart does not specifically teach the personal data comprising step data corresponding to a number of steps counted during an activity of the user.

In the same field of endeavor, Uchida teaches of a personal communication device which is able to receive personal data of a user and wherein the personal data comprises step data corresponding to a number of steps counted during an activity of the user, (page 22, lines 8-11 (col. 13, lines - col. 14, line 4 from US 6,252,883); page 23, lines 12-20 (col. 14, lines 47-60 from US 6,252,883); page 24, lines 15-18 (col. 16, lines 4-8 from US 6,252,883)).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Schweickart by counting the number of steps counted during an activity of the user as taught by Uchida so that the persons can be closely monitored if they have a chronic illness and they are performing strenuous activity such as mountain climbing or excessive number of steps during an activity.

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**Regarding claims 2 and 13**, Schweickart teaches wherein the at least one personal parameter receiver is contained in a personal data capture device (e.g. wristband) attachable to the wireless/portable communication/computing device, (fig. 3; col. 5, lines 13-25).

**Regarding claims 3 and 14**, Schweickart teaches wherein the at least one personal parameter receiver is contained in the wireless/portable communication/computing device, (fig. 3; col. 5, lines 13-25).

**Regarding claims 4 and 15**, Schweickart teaches wherein the wireless/portable communication/computing device is a cellular telephone (col. 3, lines 12-13) or a personal digital assistant (PDA), (col. 3, lines 11-24).

**Regarding claims 5 and 16**, Schweickart teaches wherein the personal data is transmitted to the network server periodically, (col. 5, lines 14-16).

**Regarding claims 6 and 17**, Schweickart teaches wherein the personal data is transmitted to the network server upon receiving a user request, (col. 4, lines 61-67; col. 5, lines 17-25, 48-56).

**Regarding claims 7 and 18**, Schweickart teaches wherein the personal data comprises physical data and biometrical parameters of the user, (col. 5, lines 48-56).

**Regarding claim 11**, Schweickart teaches wherein the wireless communication device is combined with a portable computing device, (col. 3, lines 9-24).

**Regarding claims 22, 29, 36 and 43**, Schweickart teaches a multi-purpose device combining a wireless communication device with a portable/personal computing device, (col. 4, lines 42-51), the multi-purpose device comprising:

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at least one personal parameter receiver to receive personal data of a user, (col. 4, lines 42-51);

a microprocessor, coupled to the at least one personal parameter receiver, (fig. 3); and  
a memory, coupled to the microprocessor, to store the personal data, the microprocessor to transmit the personal data from the memory to a network server over a wireless network, (fig. 1; col. 5, lines 17-25, 48-56).

Schweickart does not specifically teach the personal data comprising step data corresponding to a number of steps counted during an activity of the user.

In the same field of endeavor, Uchida teaches of a personal communication device which is able to receive personal data of a user and wherein the personal data comprises step data corresponding to a number of steps counted during an activity of the user, (page 22, lines 8-11 (col. 13, lines - col. 14, line 4 from US 6,252,883); page 23, lines 12-20 (col. 14, lines 47-60 from US 6,252,883); page 24, lines 15-18 (col. 16, lines 4-8 from US 6,252,883).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Schweickart by counting the number of steps counted during an activity of the user as taught by Uchida so that the persons can be closely monitored if they have a chronic illness and they are performing strenuous activity such as mountain climbing or excessive number of steps during an activity.

***Regarding claims 23, 30, 37 and 44,*** Schweickart teaches an input device to receive a user request to transmit the personal data to the network server, (col. 5, lines 17-25, 48-56).

***Regarding claims 25, 32 and 39,*** Schweickart teaches an apparatus comprising:

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a wireless/portable communication/computing device and a multi-purpose device combining a wireless communication device and a portable computing device, (col. 4, lines 42-51); and

a personal data capture device (wristband 69; fig. 3), attachable to the wireless/portable communication/computing device, (col. 5, lines 13-25), to receive personal data of a user and to transmit the personal data to the wireless/portable communication/computing device, (col. 4, lines 42-51; col. 5, lines 13-16), the wireless/portable communication/computing device to transmit the personal data to a network server over a wireless network, (col. 5, lines 17-25, 48-56).

Schweickart does not specifically teach the personal data comprising step data corresponding to a number of steps counted during an activity of the user.

In the same field of endeavor, Uchida teaches of a personal communication device which is able to receive personal data of a user and wherein the personal data comprises step data corresponding to a number of steps counted during an activity of the user, (page 22, lines 8-11 (col. 13, lines - col. 14, line 4 from US 6,252,883); page 23, lines 12-20 (col. 14, lines 47-60 from US 6,252,883); page 24, lines 15-18 (col. 16, lines 4-8 from US 6,252,883).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Schweickart by counting the number of steps counted during an activity of the user as taught by Uchida so that the persons can be closely monitored if they have a chronic illness and they are performing strenuous activity such as mountain climbing or excessive number of steps during an activity.

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***Regarding claims 26,33 and 40***, Schweickart teaches wherein the wireless/portable communication/computing device is a cellular telephone or personal digital assistant (PDA). (col. 3, lines 11-24).

***Regarding claims 27,34 and 41***, Schweickart teaches wherein the personal data capture device comprises an input device to receive a user request to transmit the personal data to the network server, (col. 5, lines 17-25,48-56).

5. Claims 8-10,19-21,24,28,31,35,38,42 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schweickart in view of Uchida et al. and further in view of Goodman US Patent 5,827,180.

***Regarding claims 8-10,19-21,24,28,31,35,38,42 and 45***, while Schweickart teaches of generating feedback information pertaining to the personal data, Schweickart does not specifically teach of displaying the information to the user. However, Schweickart suggests of displaying the information to medical personal or other individuals therefore, it would have been obvious to display the information to the user so that the user will know their current medical status.

Nonetheless, Goodman teaches that it was well known in the art to monitor a user with a personal communication device and to generate feedback information pertaining to personal data and to display the information on the display of the personal communication device, (abstract; fig. 2; col. 2, lines 61-65; col. 4, lines 45-62).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Schweickart and Uchida by displaying the information to the user on their personal communication device as taught by Goodman so that



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the user will know their medical status so that they can administer more medication or call their health care provider if the received information warrants such action.

***Response to Arguments***

6. Applicant's arguments with respect to claims 1-47 have been considered but are moot in view of the new ground(s) of rejection. However, the Examiner would like to respond to Applicant's argument that Schweickart teaches away from utilizing the data since the user in Schweickart is bedridden and shown as not being active and that in other description the patient are being coupled to an intravenous drip controller.

While the Examiner acknowledges that it may not be typical for at least a bedridden person connected to an intravenous drip controller to be highly active the embodiments of Schweickart is shown only for different types of scenarios that the device can be used and it is not limited to only be used for those types of persons. For example, figure 1 also shows that an active person 22 (non bedridden person) is carrying the personal data device and is free to walk about. Therefore, the Examiner believes that Schweickart does not teach away from the newly added limitations and one of ordinary skill in the art would have been motivated to modify Schweickart to include a step counter for the reasons set forth in the above combination.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any response to this action should be mailed to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

or faxed to:

(703) 872-9306, (for formal communications intended for entry)

Or:

(703) 872-9306, (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to 220 South 20<sup>th</sup> Street Crystal  
Plaza Two, Lobby, Room 1B03, Arlington, VA 22202

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ovidio Escalante whose telephone number is 703-308-6262. The examiner can normally be reached on M-F (6:30AM - 5:00PM).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S Tsang can be reached on 703-305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ovidio Escalante  
Examiner  
Group 2645  
August 20, 2004

FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

A handwritten signature in black ink, appearing to read 'Fan Tsang', with a long horizontal flourish extending to the right.